



# UNITED STATES PATENT AND TRADEMARK OFFICE

*cy*  
UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.				
10/551,933	10/04/2005	Amjad Ali	21150P	6475				
210 MERCK AND CO., INC P O BOX 2000 RAHWAY, NJ 07065-0907	7590 12/10/2007		<table border="1"><tr><td colspan="2">EXAMINER</td></tr><tr><td colspan="2">LOEWE, SUN JAE Y</td></tr></table>		EXAMINER		LOEWE, SUN JAE Y	
EXAMINER								
LOEWE, SUN JAE Y								
			<table border="1"><tr><td>ART UNIT</td><td>PAPER NUMBER</td></tr><tr><td>1626</td><td></td></tr></table>		ART UNIT	PAPER NUMBER	1626	
ART UNIT	PAPER NUMBER							
1626								
			<table border="1"><tr><td>MAIL DATE</td><td>DELIVERY MODE</td></tr><tr><td>12/10/2007</td><td>PAPER</td></tr></table>		MAIL DATE	DELIVERY MODE	12/10/2007	PAPER
MAIL DATE	DELIVERY MODE							
12/10/2007	PAPER							

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/551,933	ALI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Sun Jae Y. Loewe	1626	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 October 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8-14,22,28 and 29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12,13 is/are allowed.
- 6) ☒ Claim(s) 8-10,22,28 and 29 is/are rejected.
- 7) ☒ Claim(s) 11 and 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 8-14, 22, 28 and 29 are pending in the instant application. Claims 24-27 were cancelled by preliminary amendment file don October 4, 2005. Claims 1-7, 15-21 and 23 were cancelled by amendment filed on October 26, 2007.

### ***Response to Amendment***

2. The amendment filed on October 26, 20007 overcomes all grounds of objection/rejection set forth in the previous office action. Therefore, the 35 USC 112 and 35 USC 102 rejections are hereby withdrawn.

3. The following new grounds of rejection are made in this office action: claims objections (sections 4-6); 35 USC 102 rejection (section 7).

### ***Claim Objections***

4. Claim 8 is objected to because of the following informality: claimed variable R<sup>1</sup> is not defined in proper Markush format. The following correction is suggested to overcome this ground of objection: a) insert the word “and” between options (d) and (e); b) delete the word “and” that follows option (e).

5. Claim 11 is objected to because of the following informality: the claim does not end in a period. Appropriate correction is required pursuant MPEP § 608.01 (m).

6. Claim 14 is objected to because of the following informality: the claim is not written in proper alternative or Markush format. The following correction is suggested to overcome this ground of objection: insert “and” or “or” on page 28 before the table identifier "viii)".

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

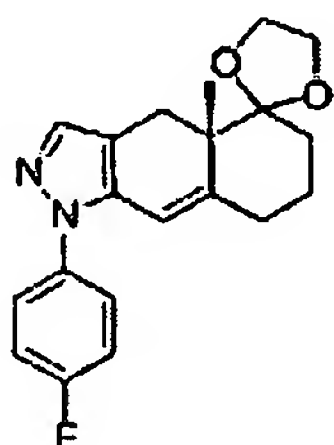
A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 8-10, 22, 28 and 29 rejected under 35 U.S.C. 102(e) as being anticipated by the following three references: a) Ali et al. (WO 04/075840; step 3 on p. 37); b) Ali et al. (WO 04/026248, step c on p. 39); c) Ali et al. (WO 2003/086294, step 3 on p. 43).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

The three references teach the compound shown below in a composition comprising 40 mL of acetic acid in 1 L of water (ie. aqueous solution).



### *Conclusion*

8. Claims 8-10, 22, 28 and 29 rejected. Claims 11 and 14 objected. Claims 12 and 13 allowed.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sun Jae Y. Loewe whose telephone number is (571) 272-9074. The examiner can normally be reached on M-F 7:30-5:00 Est.

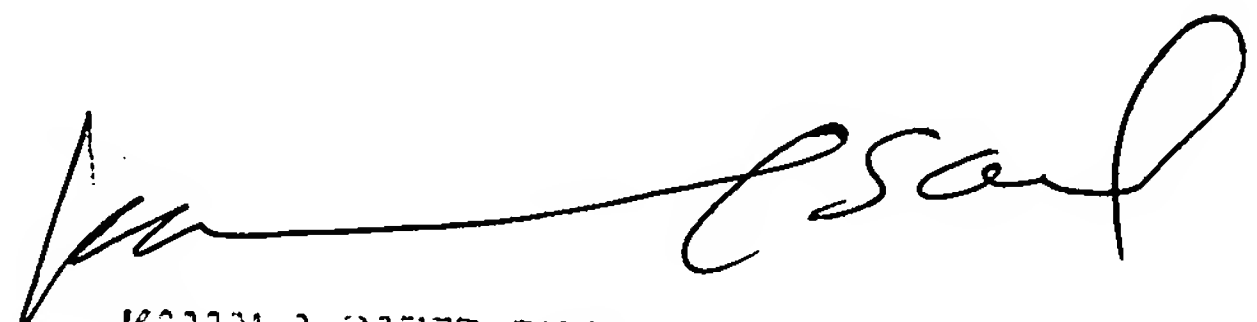
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571)272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application/Control Number:  
10/551,933  
Art Unit: 1626

Page 5

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Sun Jae Y. Loewe  
Art Unit 1626



SUN JAE Y. LOEWE, D.D.  
ATTORNEY